

SEP 27 2005


BANNER & WITCOFF, LTD.
 INTELLECTUAL PROPERTY LAW

 601 SW SECOND AVENUE, #1900
 PORTLAND, OREGON 97204

 TEL: 503.425.6800
 FAX: 503.425.6801
www.bannerwitcoff.com

FACSIMILE TRANSMITTAL SHEET

To:	FROM:
Examiner K. Tran	Byron S. Kuzara
COMPANY:	DATE:
U.S.P.T.O.	September 27, 2005
FAX NUMBER:	TOTAL NO. OF PAGES:
703-872-0006 571-273-8300	19
RE:	OUR REFERENCE NO.:
U.S. Serial No. 10/787,162	000407.00027

If you do not receive all page(s) or have any problems receiving this transmission, please call:

NAME: Lesa Wolman	PHONE: 503-425-6800
--------------------------	----------------------------

COMMENTS:

IMPORTANT/CONFIDENTIAL: This message is intended only for the use of the individual or entity to whom it is addressed. This message contains information from the law firm of BANNER & WITCOFF, LTD. which may be privileged, confidential or exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution, retention, archiving, or copying of the communication is strictly prohibited. If you have received this communication in error, please notify us immediately at our telephone number listed above. We will be happy to arrange for the return of this message to our offices at no cost to you.

CHICAGO

WASHINGTON, D.C.

BOSTON

PORTLAND,
OR

PTO/SB/07 (05-03)

Approved for use through 04/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

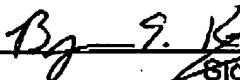
Under the Paperwork Reduction Act of 1985, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office

on 9/27/05.

Date



Signature

Byron S. Kuzara, #51,255

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Response (10 pages)

Excerpts from Microsoft Computer Dictionary (6 pages)

One Month Petition for Extension of Time (1 page)

Serial No. 10/787,162

Attorney Docket No. 000407.00027

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER

SEP 27 2005

Certificate Of Transmission

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office at telephone number (571) 273-8300 on September 27, 2005.

Respectfully submitted,

By S. K.
By: Byron S. Kuzar
Registration Number 51,255
Banner & Witcoff, Ltd.

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
)
 Hideki SADAKATA, et al.) Art Unit: 3651
)
 Serial Number 10/787,162) Examiner: Tran, K.
)
 Filed: February 27, 2004) Attorney Reference: 000407.00027
)
 For: VENDING MACHINE AND PORTABLE)
 RECORDING MEDIUM HAVING)
 RECORDED THEREIN OPERATION)
 DATA TRANSFER PROGRAM FOR)
 VENDING MACHINE)

RESPONSE

Commissioner for Patents
Alexandria, VA 22313

Sir:

The Office Action mailed June 2, 2005 has been carefully reviewed and, in view of the following remarks, reconsideration and allowance of the application are respectfully requested.

I. Summary of Claims

Claims 1-4 are currently pending in the application, with claims 1 and 4 being independent claims. No claims are amended, cancelled, or added in connection with this Response.

II. Summary of Rejections

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1, 2, and 4 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number 6,644,495 to Ruskin, et al.;
- Claims 1 and 4 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number 6,498,965 to Matsumoto;
- Claims 2 and 3 are rejected under 35 U.S.C. §103 as being obvious over the combination of Ruskin and Matsumoto; and
- Claim 3 is rejected under 35 U.S.C. §103 as being obvious over Matsumoto.

III. Applied Prior Art*Discussion of Ruskin*

Ruskin discloses a processing method for vending machine with substitute magazines. According to Ruskin, a memory device (e.g., a machine-readable recording medium, and preferably a memory chip-mounting smart-card) is utilized "to program the location and prices of goods in a vending machine, to record the sale transactions, including the amount of currency collected in connection with a previously installed magazine that is being replaced, and to provide a fool-proof reconciliation between the contents of a returned magazine and those sale transactions" (Ruskin, column 1, lines 54-62). Data associated with goods stored in the vending machine and goods sold by the vending machine, for example, are stored in the memory device (e.g., smart-card). "After entering the password which allows opening of the vending machine, the sale data accumulated by the vending machine is downloaded...onto the service person's smart-card. The downloading of the data associated with the previously installed magazine, that is being replaced and is to be returned to the processing location terminates the first half of the data processing associated with the magazine substitution. The machine, then, extracts...from

the smart-card, the menu corresponding to the magazine that is about to be installed. The machine is now programmed to vend each item in the newly installed magazine upon a payment specified on the down-loaded menu" (Ruskin, column 3, lines 9-20).

Discussion of Matsumoto

Matsumoto discloses a system for controlling a vending machine. According to Matsumoto, the vending machine includes an input section 103 "for inputting the new control program 601, new data 602 used to execute the new control program 601 and a rewriting program 603 of the new control program 601 to the transfer control section 104. The specific configuration of this input section 103 is determined by a medium used to input the new control program 601, etc." (Matsumoto, column 4, lines 24-29). In other words, input section 103 is utilized to transfer a new control program, data, and a rewriting program from a memory medium to the vending machine. Once the new control program, data, and rewriting program are stored in the vending machine, the rewriting program is executed to rewrite the prior control program with the new control program.

IV. Discussion of Independent Claim 1

Independent claim 1 recites a vending machine having a controller, a storage, and a central processing unit. The controller has an interface to which a portable recording medium is detachably mountable, and the storage has operation data stored therein. The central processing unit executes an operation data transfer program, which is stored in advance in the portable recording medium mounted to the interface and executed from the portable recording medium. Execution of the transfer program transfers the operation data from the storage to the portable recording medium or transfers the operation data from the portable recording medium to the storage.

Independent claim 1 is rejected as being anticipated by each of Ruskin and Matsumoto. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In addition to other elements, independent claim 1 recites the following:

- An operation data transfer program is stored on a portable recording medium, and

• The operation data transfer program is executed from the portable recording medium. As discussed in detail below, neither Ruskin nor Matsumoto teach or suggest these elements of independent claim 1. Accordingly, neither Ruskin nor Matsumoto anticipate independent claim 1.

Discussion of Ruskin

Ruskin discloses that data on a previously-installed magazine and a magazine to be installed are stored on the memory device. According to the above discussion of Ruskin, two download transactions occur after a password is entered: First, sale data is downloaded to the smart-card. Second, "The machine, then, extracts...from the smart-card, the menu corresponding to the magazine that is about to be installed" (Ruskin, column 3, lines 16-18).

According to independent claim 1, the operation data transfer program is stored in the portable recording medium. The purpose of the operation data transfer program is "to thereby transfer the operation data from said storage to said portable recording medium or transfer the operation data from said portable recording medium to said storage." The operation data transfer program, therefore, facilitates the transfer of data between the vending machine and the portable recording medium.

In contrast with independent claim 1, Ruskin does not disclose the concept of storing a transfer program on a portable memory device. More particularly, Ruskin is effectively silent as to the location of a program that transfers data between the vending machine and the smart-card. One skilled in the art would be led, however, to believe that such a program is stored in the vending machine itself. As stated in Ruskin, "The machine, then, extracts...from the smart-card, the menu corresponding to the magazine that is about to be installed" (Ruskin, column 3, lines 16-18). This passage suggests that "the machine" includes the necessary program to facilitate data transfer. Accordingly, the Applicants submit that independent claim 1 is allowable over Ruskin because Ruskin does not teach or suggest the concept of storing an operation data transfer program on a portable memory device.

Furthermore, Ruskin does not teach or suggest the concept of executing an operation data transfer program from a portable recording medium. Given, as discussed above, that Ruskin does not teach or suggest the concept of storing the operation data transfer program on the

portable memory device, then Ruskin cannot teach or suggest executing the operation data transfer program from the portable recording medium.

Even if Ruskin disclosed the concept of an operation data transfer program that is stored on a portable recording medium (which Applicants do not concede), Ruskin does not disclose the concept of an operation data transfer program that is executed from a portable recording medium. In Ruskin, data are stored on a hard drive or other storage within the vending machine, and the data are executed from the hard drive or other storage within the vending machine. In contrast with independent claim 1, therefore, Ruskin does not teach or suggest executing a program from a portable recording medium.

Based upon the above discussion, the Applicants submit that independent claim 1 is allowable over Ruskin. Claim 2, which depends from independent claim 1, should be allowable for at least the same reasons.

Burden of Proof

The burden of proof rests with the U.S.P.T.O. (i.e., the Examiner) to show that a claim is anticipated by the prior art. More particularly, "Whenever, on examination, any claim for a patent is rejected...the Director shall notify the applicant thereof, stating the reasons for such rejection...together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application" (35 U.S.C. §132(a)). Furthermore, "Once Office personnel have concluded the above analyses of the claimed invention under all the statutory provisions, including 35 U.S.C. 101, 112, 102 and 103, they should review all the proposed rejections and their bases to confirm their correctness. Only then should any rejection be imposed in an Office action. *The Office action should clearly communicate the findings, conclusions and reasons which support them*" (MPEP §2106, emphasis added).

The Office Action presents a rejection of independent claim 1, but fails to state the reasons for the rejection with information, references, and reasons useful in judging the propriety of continuing prosecution of the application, as required by both 35 U.S.C. §132(a) and MPEP §2106. The rejection of independent claim 1 over Ruskin merely states conclusions (i.e., that Ruskin discloses various features of independent claim 1) without providing any references as to where these features are found in Ruskin. That is, the rejection provides no information, references, or reasons to support the conclusions of the Examiner. The Applicants submit,

therefore, that the Examiner has not presented a *prima facie* case of anticipation and invites the Examiner to demonstrate where the various elements of independent claim 1 are disclosed in Ruskin.

Discussion of Matsumoto

As discussed above, Matsumoto discloses that an input section is utilized to transfer a new control program, data, and a rewriting program from a memory medium to the vending machine. Once the new control program, data, and rewriting program are stored in the vending machine, the rewriting program is executed to rewrite the prior control program with the new control program. Accordingly, Matsumoto discloses a process wherein programs are downloaded to a hard drive or other storage prior to executing the programs.

In contrast with independent claim 1, Matsumoto does not disclose the concept of an operation data transfer program that is stored on a portable recording medium. Rather, Matsumoto discloses storing a new control program, data, and a rewriting program on a memory medium. As discussed with respect to Ruskin, independent claim 1 expressly recites that the operation data transfer program is utilized to "transfer the operation data from said storage to said portable recording medium or transfer the operation data from said portable recording medium to said storage." The operation data transfer program is, therefore, a program that facilitates the transfer of the data. The mere fact that the new control program, data, and rewriting program disclosed in Matsumoto are transferred to the vending machine does not teach or suggest that the program facilitating the transfer is stored on the memory medium. In fact, Matsumoto states that input section 103 of the vending machine (not the memory medium) is used "for inputting the new control program 601, new data 602...and a rewriting program 603...to the transfer control section 104" (Matsumoto, column 4, lines 24-26). Accordingly, input section 103 of the vending machine facilitates transfer, not an operation data transfer program that is stored on the memory medium. Based upon the above discussion, Matsumoto does not disclose an operation data transfer program, as recited by independent claim 1.

Furthermore, the Applicants wish to note that the rewriting program of Matsumoto is not disclosed as facilitating transfer between the memory medium and the vending machine. Rather, the rewriting program is utilized to replace an old control program with a new program following download from the memory medium.

Even if Matsumoto disclosed the concept of an operation data transfer program that is stored on a portable recording medium (which Applicants do not concede), Matsumoto does not disclose the concept of an operation data transfer program that is executed from a portable recording medium. In Matsumoto, programs are stored on a hard drive or other storage within the vending machine immediately before the programs are executed, and the programs are executed from the hard drive or other storage within the vending machine. In contrast with independent claim 1, therefore, Matsumoto does not teach or suggest executing a program from a portable recording medium.

As discussed above, Matsumoto discloses downloading a new control program, data, and a rewriting program from a memory medium to the vending machine. Once the new control program, data, and rewriting program are stored in the vending machine, the rewriting program is executed to rewrite the prior control program with the new control program. Accordingly, programs and data are downloaded to the vending machine before the programs are executed. In contrast, independent claim 1 recites executing a program from a portable recording medium. One manner in which this may be performed is by providing the CPU with direct access to a memory space in the portable recording medium. That is, the CPU may access the operation data transfer program without the necessity of downloading the program or otherwise transferring data. Even if executing the program includes transferring data from the portable recording medium to the vending machine, a program execution operation is performed prior to a data transfer operation in independent claim 1. That is, the limitation in independent claim 1 stating that the operation data transfer program is executed from the portable recording medium indicates that a program execution operation is performed prior to a data transfer operation.

Based upon the above discussion, the Applicants submit that independent claim 1 is allowable over Matsumoto.

Response to Examiner's Comments

In response to arguments similar to the above arguments, the Examiner stated that according to Ruskin and Matsumoto "the portable memory devices include new downloadable programs for affecting new operational procedures for the vending machines. The new downloadable programs are transfer programs. The new programs are downloaded from the portable medium onto on the vending machines. Therefore, the programs are executed from the

portable medium" (Office Action mailed June 2, 2005, page 4, final paragraph). These comments are discussed below in the context of Ruskin, but apply in a substantially similar manner to Matsumoto.

Contrary to the Examiner's comments, Ruskin does not disclose the concept of storing programs on a portable memory device. Rather, Ruskin discloses the concept of storing data on a portable memory device. According to Ruskin, the smart-card stores "sale data accumulated by the vending machine...data associated with the previously installed magazine.... [and] the menu corresponding to the magazine that is about to be installed" (Ruskin, column 3, lines 10-18). Data is significantly different than a program. Attached to this Response are excerpts from the Microsoft Computer Dictionary, fourth edition, published by Microsoft Press in Redmond, Washington, USA, 1999. According to the Microsoft Computer Dictionary, data is "an item of information" (Microsoft Computer Dictionary, page 122). In contrast, a program is a "sequence of instructions that can be executed by a computer" (Microsoft Computer Dictionary, page 359). Whereas data is information, a program is a series of instructions. Despite these literal definitions, it is recognized that data may be either executable or non-executable. If executable, data could be construed as having similarities to a program. The disclosure in Ruskin, however, would be interpreted by one skilled in the art as relating to non-executable data as it is merely information relating to products stored or stocked in the vending machine. Accordingly, Ruskin does not disclose programs, as contended by the Examiner.

Even if one skilled in the art would consider the data to be a program (which the Applicants do not concede), the data is not a transfer program. According to the express language of independent claim 1, the operation data transfer program is utilized to "transfer the operation data from said storage to said portable recording medium or transfer the operation data from said portable recording medium to said storage." The operation data transfer program is, therefore, a program that facilitates the transfer of the data. The mere fact that the data disclosed in Ruskin may be transferred, does not make the data a program that facilitates data transfer. The data disclosed in Ruskin is not, therefore, a transfer program as expressly defined by independent claim 1.

As a final matter, Ruskin does not disclose the concept of executing a program from a portable recording medium. Rather, Ruskin discloses the concept of downloading data from a smart-card. The Examiner's comments state that "programs are downloaded from the portable

medium onto on the vending machines. Therefore, the programs are executed from the portable medium" (Office Action mailed June 2, 2005, page 4, final paragraph). Downloading is significantly different than executing. According to the Microsoft Computer Dictionary, downloading is "to transfer a copy of a file from a remote computer to the requesting computer by means of a modem or network" (Microsoft Computer Dictionary, page 153). In contrast, executing is "to perform an instruction" (Microsoft Computer Dictionary, page 173). Whereas downloading involves copying a file, executing involves performing an instruction. Accordingly, downloading is not equivalent to executing, and the mere fact that data is downloaded does not imply that a program is executed.

V. Discussion of Obviousness Rejection

Claims 2 and 3 are rejected as being obvious over the combination of Ruskin and Matsumoto. The various arguments discussed above for independent claim 1 apply equally to claims 2 and 3. As discussed above, independent claim 1 (and therefore dependent claims 2 and 3) recite that an operation data transfer program is stored on a portable recording medium, and the operation data transfer program is executed from the portable recording medium. Given that neither Ruskin nor Matsumoto teach or suggest these elements, then the combination of Ruskin and Matsumoto does not teach or suggest these elements. Accordingly, the Applicants respectfully submit that claims 2 and 3 are allowable over the combination of Ruskin and Matsumoto for the same reasons that are disclosed above with respect to independent claim 1.

VI. Discussion of Independent Claim 4

Independent claim 4 recites a portable recording medium having recorded therein an operation data transfer program. A vending machine includes a controller having an interface to which a portable recording medium is detachably mountable, a storage having operation data stored therein, and a central processing unit. The operation data transfer program functions as means for transferring operation data from the storage to the portable recording medium or transferring the operation data from said portable recording medium to said storage. In addition, the operation data transfer program is executed from the portable recording medium.

Independent claim 4 is rejected as being anticipated by each of Ruskin and Matsumoto. In contrast with independent claim 4, neither Ruskin nor Matsumoto disclose the concept of

storing a transfer program on a portable memory device or the concept of executing a transfer program from a portable memory device. Accordingly, the Applicants respectfully submit that independent claim 4 is allowable over each of Ruskin and Matsumoto for the same reasons that are disclosed above with respect to independent claim 1.

VII. Conclusion

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Response is being timely filed by facsimile transmission on September 27, 2005 with a one-month Petition for Extension of Time. Should additional fees or an additional extension of time be deemed necessary for consideration of this Response, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for payment. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

By: 
Byron S. Kuzara
Registration No. 51,255

Banner & Witcoff, Ltd.
1001 G Street, N.W.
Washington, D.C. 20001-4597
Telephone: (202) 824-3000

Dated: September 27, 2005